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| 10/760,256 | 01/21/2004 | Kia Silverbrook | WAL08US | 1578 |

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BALMAIN, 2041
AUSTRALIA

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| EXAMINER |
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COLILLA, DANIEL JAMES

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| ART UNIT | PAPER NUMBER |
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2854

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,256

Applicant(s)

SILVERBROOK ET AL.

Examiner

Daniel J. Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11, 17-30, 33-36 and 41-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-16, 31, 37-40, 48 and 49 is/are rejected.
- 7) ☐ Claim(s) 12 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/12/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-9, 12-16, 31, 32, 37-40, 48 and 49 in the reply filed on 4/11/2005 is acknowledged.

Claims 10-11, 17-30, 33-36 and 41-47 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Objections

2. Claims 7-9, 31, 37, 38 are objected to because of the following informalities:

"The configuration," in claims 7-9, has no antecedent basis in the claims.

Claims 31, 37, 38, 48 and 49 each contain numerous double recitations of structure and/or method steps already recited in claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 39 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claim 39 recites, "A method as claimed in claim 1 for operating a wallpaper printing franchise." However, claim 1 does not recite a method of operating a

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wallpaper franchise, instead, claim 1 recites, “a method of printing wallpaper onto a web of media.” This inconsistency between preambles creates confusion on exactly what applicant is attempting to claim.

Similarly, the preamble of claim 49 is not consistent with that of claim 1. In claim 49, applicant recites “a method as claimed in claim 1 for producing wallpaper on-demand.” As mentioned above, this is not congruent with the preamble of claim 1.

Double Patenting

5. Claim 39 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 40 of copending Application No. 10/760,214 in view of Martin (US 2002/0171692).

Claim 40 of Application No. 10/760,214 discloses the claimed method for operating a wallpaper printing franchise almost exactly except for the particulars of the method of printing wallpaper. Martin discloses the claimed method for printing wallpaper including a web of media 27, a cabinet (housing of printer 18), a media path in the cabinet in which a printhead 20 is located and control electronics 38 which include a microprocessor as mentioned in paragraph [0009], lines 15-16 of Martin. A media winding area and loading area are shown below, in the 102 prior art rejection of claim 1, in the Figure taken from Figure 2 of Martin. Martin further discloses using input devices 36 and 37 for receiving operator inputs. The operator can arrange digital images (thus creating a specification for an operator's requirements) using the input devices (the microprocessor capturing data from the input devices). The operator can further specify his requirements by selecting decorative shapes, borders or image processing effects as

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mentioned in paragraph [0010], lines 7-11 of Martin. It would have been obvious to combine the teaching of Martin with claim 40 Application No. 10/760,214 for the advantage of the winding area which conveniently allows the operator to wind the printed wallpaper.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-4, 7, 13, 40 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (US 2002/0171692).

With respect to claim 1, Martin discloses the claimed method for printing wallpaper including a web of media 27, a cabinet (housing of on-demand printer 18), a media path in the cabinet in which a printhead 20 is located and control electronics 38 which include a microprocessor as mentioned in paragraph [0009], lines 15-16 of Martin. A media winding area and loading area are shown below in the Figure taken from Figure 2 of Martin:

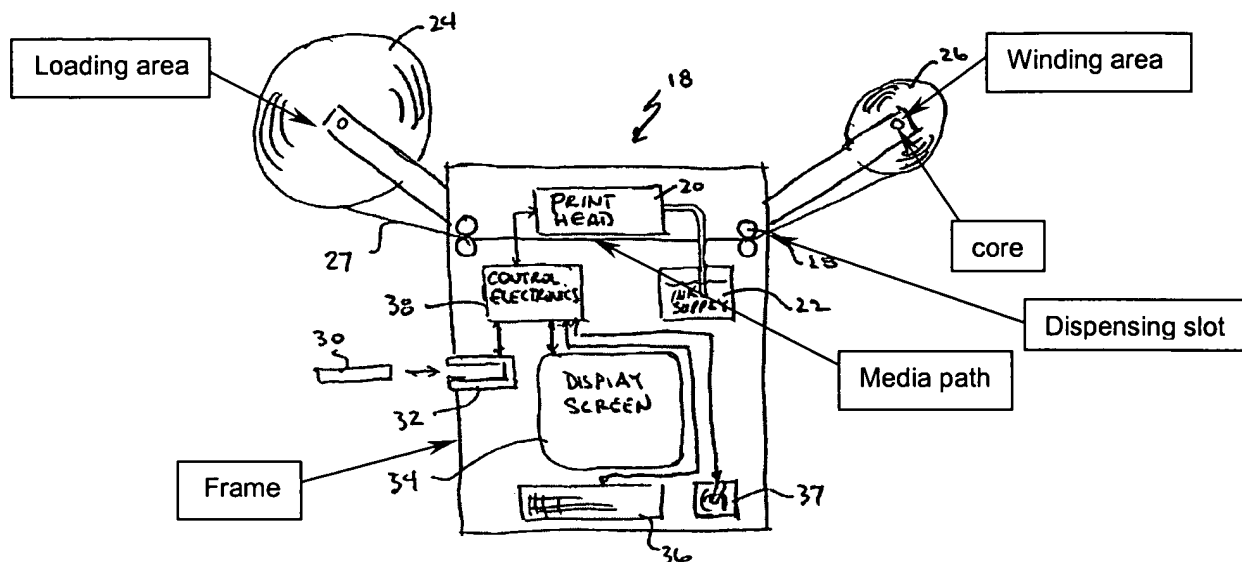


FIG. 2

Martin further discloses using input devices 36 and 37 for receiving operator inputs. The operator can arrange digital images (thus creating a specification for an operator's requirements) using the input devices (the microprocessor capturing data from the input devices). The operator can further specify his requirements by selecting decorative shapes, borders or image processing effects as mentioned in paragraph [0010], lines 7-11 of Martin.

With respect to claim 3, Martin discloses a source of personal digital images (patterns) on a storage device 30 such as a digital memory card or picture CD (paragraph [0009], lines 9-12) which is located in the cabinet as shown in Figure 2 of Martin. The digital images are inherently selectable since the microprocessor allows the user to compose a wallpaper border pattern using the personal images.

With respect to claim 4, Martin discloses a display screen 34 for depicting the selected pattern (paragraph [0010], lines 3-7).

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With respect to claim 7, applicant has not defined what the “configuration” is in the claims. To the extent that this term is understood, it appears that Martin discloses displaying the configuration on display screen 34. The display of the arrangement of personal digital images and decorative shapes, image processing effects, as mentioned in paragraphs [0009] and [0010] is considered to be the display of the configuration.

With respect to claim 13, Martin discloses that the operator can apply image processing effects which would result in a modification to the pattern (paragraph [0010], lines 9-11).

With respect to claim 40, Martin discloses the recited method and structure as mentioned above with respect to claim 1. Martin further discloses a frame in which is located the media path and a core as shown above in the Figure taken from Figure 2 of Martin. The core is removable in the sense that it can be removed by reversing the process in which it was assembled.

With respect to claim 49, Martin discloses the recited structure and method as mentioned above with respect to claim 1 and additionally discloses a configuration and a dispensing slot as shown in the Figure above taken from Figure 2 of Martin. The configuration is the length, borders and image processing effects input by the operator as mentioned in paragraph [0010], lines 7-15.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692) as applied to claims 1, 3-4, 7, 13, 40 and 49 above, and further in view of Goldstein (US 2002/0069078).

Martin discloses the claimed method for printing wallpaper except for using the video display 34 as a touch screen input device. However, Goldstein teaches a method of printing wallpaper (see abstract) including the step of utilizing a touch screen to interact with a website that operates with a custom wallpaper creation program 102 (Goldstein, paragraph, [0058], lines 22-27). It would have been obvious to combine the teaching of Goldstein with the method of printing wallpaper disclosed by Martin because a touch screen provides a commonly known operator interface.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692) as applied to claims 1, 3-4, 7, 13, 40 and 49 above, and further in view of Gerber (WO 03/064170).

Martin discloses the claimed method for printing wallpaper except for the step of providing the printer with a scanner for capturing data that specifies a selected pattern. However, Gerber discloses a method of printing wallpaper (see page 2, lines 1-23), including the step of providing a scanner 24 for scanning existing designs and/or patterns (i.e., capturing data that specifies a selected pattern) to be used in a wallpaper design (page 3, lines 18-20; 31-33). It would have been obvious to combine the teaching of

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Gerber with the method disclosed by Martin for the advantage of allowing an operator to select any existing hardcopy print or pattern for use in a wallpaper design.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692) as applied to claims 1, 3-4, 7, 13, 40 and 49 above, and further in view of Ogura et al. (JP 01-053968).

Martin discloses the claimed method of printing except for the step of loading a media cartridge into the printer and the step of automatically threading the media from the loading area to the winding area. However, Ogura et al. discloses loading a media cartridge 1 into a printer as shown in Figures 1, 2, 5, 6 and 12 of Ogura et al. The cartridge 1 contains unprinted media as stated in the first sentence of the Constitution portion of the English abstract. Ogura et al. further discloses using a motor 137 for advancing the unprinted web into the printing path of the printer. It would have been obvious to combine the teaching of Ogura et al. with the method of printing disclosed by Martin for the advantage of a simple process of installing the unprinted media and removing the printed media, and for the advantage of protecting the media from the outside and printer environments. It is inherent that the media is threaded from the loading area to the winding area in order for the printer to operate. However, it is not known to the examiner if this step is automatic or not. However, it has been held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art (see MPEP § 2144.04, part III). It would have been obvious to automatically thread the media to create less manual work for the operator.

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692) in view of Ogura et al. (JP 01-053968) as applied to claim 14 above, and further in view of Bilek (US 4,322,044).

Martin in view of Ogura et al. discloses the claimed method of printing wallpaper except for the step of severing the printed roll on the core from the web. Martin discloses loading a media tote 1 into the winding area as shown in Figures 1, 2, 5, 6, 12 and 19 of Martin. Further disclosed is winding a printed roll of paper onto a core 7 inside the tote 1 (see second sentence of the Constitution portion of the English abstract). Bilek teaches a printer with a take-up roll core 39 and a paper tear bar 34 used for severing the print media web 19 from the supply roll 17 (Bilek, c ol. 3, lines 21-22). It would have been obvious to combine the teaching of Bilek with the printing method disclosed by Martin in view of Ogura et al. for the advantage of readily having a device available for separating the take-up roll core from the supply of web media.

13. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692) in view of Ogura et al. (JP 01-053968) as applied to claim 14 above, and further in view of Yada et al. (JP 2003063700) and Oda (JP 03147899).

Martin in view of Ogura et al. discloses the claimed method for printing wallpaper as mentioned above with respect to claim 14, except that Martin does not disclose a pilot guide or an additional motor. Martin additionally discloses a dispensing slot as shown in the above Figure taken from Figure 2 of Martin. Ogura et al. teaches a media cartridge 1 with a supply slot 5 as shown in Figure 2 of Ogura et al. Yada et al. teaches a pilot guide

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4220 for print media 100b as shown in Figure 15 of Yada et al. In the combination the supply slot It would have been obvious to combine the teaching of Yada et al. with the printing method disclosed by Martin in view of Ogura et al. for the advantage of guiding the print media in the desired direction through the printer so that it does not jam and disrupt the printing process.

Oda teaches a printer with two motors for feeding the print media 4. The motor 18 is connected to the winding core 16 as shown in Figure 1 of Oda. It would have been obvious to combine the teaching of Oda with the printing method disclosed by Martin in view of Ogura et al. for the advantage of assisting the print media in moving through the printer and winding up on the winding core 16. In particular this would be useful when a large roll of media is being printed and the winding core gets difficult to move.

Allowable Subject Matter

14. Claims 12 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Claim 39 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action, to the satisfaction of the examiner, and if the provisional double patenting rejection is overcome.

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16. The following is a statement of reasons for the indication of allowable subject matter:

Claim 12 has been indicated as containing allowable subject matter because the prior art of record does not teach alone or in combination the method of printing wallpaper including the steps of providing one or more collections of patterns; each pattern in a collection having a symbol which can be used as an operator input.

Claim 32 has been indicated as containing allowable subject matter primarily for the case having two halves hinged together; the two halves defining a media supply slot, and a pair of rollers adjacent the slot.

Claim 39 has been indicated as containing allowable subject matter primarily for the steps of providing to franchisees, an on-demand printer, providing franchisees with a collection of patterns in a digital storage medium, enabling the franchisee to print a roll of wallpaper and obtaining or attempting to obtain a fee from the franchisee.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kato et al, Krinsky, Milliasseau et al., Gerber and Edwards et al. are cited to show other examples of methods for printing wallpaper on-demand with operator specifications.


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 16, 2005



Daniel G. Colilla
Primary Examiner
Art Unit 2854